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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,509	07/17/2000	FUMITAKE YODO	6715/60188	7100

7590 09/12/2005

JAY H MAIOLI
COOPER & DUNHAM
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/600,509

Applicant(s)

YODO, FUMITAKE

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,5 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,4,5 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. Applicant's amendment filed June 13, 2005 is acknowledged. Accordingly, claims 1, 4, 5, and 7 remain pending.
2. All references in this Office Action to the capitalized versions of "Applicant" refers specifically the Applicant of record. References to lower case versions of "applicant" or "applicants" refers to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" in this Office Action refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally.
3. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologies for these errors.

Claim Rejections - 35 USC §103

4. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4, 5, and 7 are rejected under 35 U.S.C. §103(a) as being unpatentable over Peterson, Jr. (U.S. 5,857,020) ("Peterson '020") in view of Kupka et. al. (U.S. 6,434,535 B1)("Kupka"), Akiyama et. al. (U.S. 5,539,825)("Akiyama") and White's How Computer's Work. Peterson '020 discloses a terminal with a first memory (memory storing 91), a second

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memory (memory storing 79), a first controller (94); a second controller (the digital-to-analog converter within 40); the controller reduces the accounting point information (from 91) stored in the first memory and updates the attributes of the received information from an unavailable state to an available state (decrypts the secured data making it available to the user); if the user has insufficient funds, the data is held in the unavailable state (inherent); the second controller transmits the remaining accounting point information (for an increase in funds) and the accounting point information is reset to an initial value (*e.g.* greater than or equal to \$5) based upon the status of the account processing (payment was received) (inherent in the “automatic Online process” at column 9, lines 44-53); and a communicator (40). Peterson ‘020 is silent as to whether or not the accounting points in the user’s card or elsewhere.

Akiyama directly discloses storing the accounting points on the user’s card. Moreover, Kupka discloses a process where the user’s accounting points are updated.

6. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peterson ‘020 as taught by Kupka and Akiyama to include the missing inherencies. For example, because Peterson ‘020 directly discloses “automatic Online process,” at column 9, ~ line 53, one of ordinary skill in the would understand the accounting center must perform at least one “accounting process based upon the accounting point information transmitted from the terminal device.” It is clear to those skilled in the art that if the user had only 16¢ left in his or her account, this amount is transmitted to the accounting center via the “automatic Online process” and added to any amount additionally purchased. It is also evident that the server would store the customer’s records in a central location and not just at the terminal device. “The law is clear that patent documents need not include subject matter that is known in the field of the invention and is in the prior art, for patents are written for persons

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experienced in the field of the invention. ... To hold otherwise would require every patent document to include a technical treatise for the unskilled reader.” *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1371, 59 USPQ2d 1745, 1749-50 (Fed. Cir. 2001) citing *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) (“patents are written by and for skilled artisans”).¹

7. In other words, if not inherent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peterson ‘020 as taught by Kupka to directly include the replenishing process as shown in Kupka’s Figure 8. Such a modification would have directly disclosed at least one automatic online process in Peterson ‘020 in order to add value to the user’s card.

8. Additionally, if not inherent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Peterson ‘020 as taught by Akiyama to include Akiyama’s sending of the remaining value to the accounting center. Such a modification would have directly disclosed how the card keeps the accounting balance on the card.

9. Ron White’s How Computers Work, is cited to show a modem that is old and well known in the art. See specifically How Computers Work, Chapter 27, pp 244-251.

10. As noted previously, functional recitations using the word “for,” “adapted to,” or other functional terms (*e.g.* see claim 1 which recites “adapted to store information . . . [and] adapted to update the accounting point information”) have been considered but are given little patentable

¹ See also *In re Eltgroth*, 419 F.2d 918, 921, 164 USPQ 221, 223 (CCPA 1970) (“This court has often observed that minutiae of descriptions or procedures perfectly obvious to one of ordinary skill in the art yet unfamiliar to laymen need not be set forth.”).

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weight² because they fail to add any structural limitations and are thereby regarded as intended use language. To be clear, the Examiner has considered all limitations. However a recitation of the intended use in a product claim must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

Response to Arguments

11. Applicant’s arguments filed June 13, 2005 have been fully considered but they are not persuasive.

12. Applicant argues that Peterson ‘020 fails to disclose a second controller. The Examiner respectfully disagrees. The modem used to connect to the “automatic Online process” is a second controller. For exemplary modem, see Chapter 27, pp 244-251 of Ron White’s How Computers Work. Clearly a modem is “adapted to transmitted remaining accounting point information stored in the first memory to the accounting center. In other words, ‘but for’ the modem, the system in Peterson ‘020 would not be able to connect to the “automatic Online process.”

² See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight.).

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13. Applicant also argues that Peterson '020 does not disclose the transmitting of accounting points to the accounting center. While the Examiner agrees that such features are not directly disclosed Peterson '020 since Peterson '020 is silent as to this feature, the Examiner maintains his position that this is inherent. However if not inherent, Akiyama directly discloses sending of the remaining value to the accounting center for processing.

14. Regarding functional language, Applicant's arguments are not persuasive. First, the Examiner did not say there was anything "intrinsically wrong" with functional language. Again, the Examiner has not "disregarded" functional language. *The Examiner agrees that there is nothing wrong with functional language.* In fact, the Exam miner notes that the functional language is *not* objected to and is *not* rejected under 35 U.S.C. 112 2nd paragraph. To be especially clear, functional language is fine. All cases cited by Applicant states that functional language must be considered. And again, the Examiner has considered the functional language.

15. Applicant also cited *In re Hallman*, 210 USPQ 609, 611 (CCPA 1981) on page 6 of his Remarks for the proposition "that there is nothing intrinsically wrong in defining something by what it does rather than what is it is"³ On this point the Examiner agrees.

16. Applicant adds however that "functional language in the claim must be given full weight and may not be disregarded in evaluating the patentability of the subject matter defined employing such functional language."⁴ While the Examiner agrees that all limitations must be considered and therefore can not disregarded, the Examiner has carefully reviewed *Hallman* and can not locate a statement of law which requires a claim limitation to be give "full weight" as

³ Applicant's Remarks filed June 13, 2005, Page 6.

⁴ Id.

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requested by Applicant. The Examiner therefore concludes that this latter statement of law is erroneous.

17. There are numerous examples where a reviewing body has held claim limitations are entitled to 'no weight' or that a limitation "does not have patentable weight." See *e.g. Ex parte Minks*, 169 USPQ 120, 122 (B.P.A.I. 1971) affirming the examiner's contention that a mere statement of intended use in a preamble is entitled to "no patentable weight" since the body of the claim completely defines the structure of the claimed invention; *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (noting that "Schreiber's contention that his structure will be used to dispense popcorn does not have patentable weight if the structure is already known, regardless of whether it has ever been used in any way in connection with popcorn."); and *In re Hutchison*, 154 F.2d 135, 69 USPQ 138, 141 (CCPA 1946) (noting that the recitation that an element is "adapted" is not a positive limitation but only requires the ability to perform. It "does not constitute a limitation in any patentable sense."). Therefore a statement that functional limitations must be given full weight depends upon what is meant by full weight. Moreover, it is axiomatic that in order to give any claimed phrase either full weight, some weight, or no weight, the claimed phrase must be at the very least be 'considered.' And as noted in the previous office actions, the Examiner has again 'considered' all limitations. To the extent that the Examiner has considered them, they have been given 'full weight.' To the extent the prior art must expressly recite the claim function, they are given less weight since the prior art structure is clearly capable of performing the claimed function.

18. Finally Applicant argues that "if the statement in paragraph 11 were true, "all inventions being implemented in a general purpose computer could be unpatentable over a

reference showing the structure of the general computer.” The Examiner agrees. If an applicant only claims a computer that ‘adapted to’ perform a complex function, a general purpose computer would anticipate the claim.

19. However, if an applicant claimed a general purpose computer *in combination* with software performing the complex function, the general purpose computer would clearly not anticipate the claim. The difference is in the case of the latter, the hardware is actually *programmed* to perform the claimed function resulting in a different machine. “A general purpose computer, or microprocessor, programmed to carry out an algorithm creates ‘a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software.’” *WMS Gaming, Inc. v. International Game Tech.*, 184 F.3d 1339, 1348, 51 USPQ2d 1385, 1391 (Fed. Cir. 1999) citing *In re Alappat*, 33 F.3d 1526, 1545, 31 USPQ2d 1545, 1558 (Fed. Cir. 1994) (en banc).

20. In this particular application, the Examiner concludes that because Applicant uses “adapted to” language, he has not recited a combination of hardware *and* software. In other words, because Applicant has not claimed a machine that is actually *programmed* to carry out the claimed function, he has not claimed a new machine but has instead, set forth a new use of an old machine. See *e.g. In re Benner*, 174 F.2d 938, 942, 82 USPQ 49, 53 (CCPA 1949) (“no provision has been made in the patent statutes for granting a patent upon an old product based solely upon discovery of a new use for such product”). And as noted above, a modem is clearly capable of performing the claimed function since modems can transport virtually any digitized data.

Conclusion

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

22. References considered pertinent to Applicant's disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.

23. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

25. Applicant is reminded that patents are written by and for skilled artisans. See *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) (“patents are written by and for skilled artisans”). The Examiner therefore starts with the presumption that Applicant is a skilled artisans who possess at least ordinary skill in the art. Consequently, it is the Examiner’s position that because the patent references of record are directed to those with ordinary skill in this art, these references are clear, explicit, and specific as to what they teach. Nevertheless some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process, and to help these applicants understand the contents of a reference when viewed from the position of one of ordinary skill in this art, Applicant is hereby given actual notice that if after reasonably reading any reference of record, if Applicant can not reasonably understand or if Applicants have difficulty comprehending one or more sentence(s), statement(s), diagram(s), or principle(s) set forth in one or more of the reference(s) of record, Applicant should (in his next appropriately filed response) bring this issue to the attention of the Examiner. In addition to bringing this issue to the attention of the Examiner, and in accordance with 37 C.F.R. §1.111(b), Applicant’s response must also state *why* they either do not understand or have difficulty comprehending the reference. If after properly receiving (*i.e.* Applicant’s response is made of record) both Applicant’s request for understanding and the reasons as to *why* the request is made—and assuming the reference is germane to at least one outstanding rejection—the Examiner may either provide a substitute reference, or alternatively, do his best to elucidate the particular sentence(s), statement(s), diagram(s), or principles(s) at issue in a reasonable manner.

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26. Because this application is now final, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

27. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his "Remarks" (beginning on page 5) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal

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conclusion made by the Examiner in this Office Action whether expressly stated or implied,⁵ the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (571) 272-6779. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Alexander Kalinowski, can be reached at (571) 272-6771. The fax number for facsimile responses is now (571) 273-8300.



Andrew J. Fischer
Primary Examiner
Art Unit 3627

AJF
September 4, 2005

⁵ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.